

REMARKS

Claims 49-52, 55, 63, 66, 68, 71-73, 76, 80, 84, 166-173 and 176-181 are all the claims pending in the application. Claims 63, 66 and 68 have been amended. Support for the claim amendments can be found in at least paragraphs [0280] and [0298]. Accordingly, no new matter has been introduced by way of these amendments.

Claim Objections

Claims 63 and 66 have been objected to under 37 C.F.R. 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Applicants have amended claims 63 and 66 to better capture the envisioned commercial embodiment. Applicants assert that the claim amendment renders moot the claim objections. Applicants respectfully request reconsideration and withdrawal of the claim objections.

Claim Rejections - 35 U.S.C. § 112

Claims 49-52, 55, 63, 66, 68, 71-73, 76, 80, 84, 166-173, and 176-181 have been rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. The term “about” in claim 49 was asserted to be a relative term that rendered these claims indefinite.

Applicants respectfully traverse. The term “about” is not a relative term that requires one of skill in the art to consider some indeterminate external reference to understand the metes and bounds of the claimed invention. Rather, skilled artisans can clearly recognize a range of values encompassed around the specifically recited internal values referenced in the claims. Indeed, the Court of Appeals for the Federal Circuit has considered the term “about” definite and has

construed the term in at least the following cases: Hilton Davis Chemical Co. c. Warner – Jenkinson Co., Inc., 62 F.3d 1512, 35 USPQ2d 1641 (Fed. Cir. 1995) (in banc); W.L. Gore & Associates Inc. c. Garlock Inc., 842 F.2d 1275, 6 USPQ2d 1277 (Fed. Cir. 1988); Conoco, Inc. v. May Department Stores Co., 46 F.3d 1556, 32 USPQ2d 1225 (Fed. Cir. 1994); Eiselstein v. Frank, 52 F.3d 1035, 34 USPQ2d 1467 (Fed. Cir. 1995); Quantum Corp. v. Rodine, Plc, 65 F.3d 1577, 36 USPQ2d 1162 (Fed. Cir. 1995); Pall Corp. v. Micron Separations, Inc., 66 F.3d 1211, 36 USPQ2d 1225 (Fed. Cir. 1995); and BJ Services Co. v. Halliburton Energy Services, Inc., 338 F.3d 1368, 67 USPQ2d 1692 (Fed. Cir. 2003).

In view of the comments presented above, Applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. § 112, second paragraph.

Claim Rejections - 35 U.S.C. § 102(b)

Claims 49, 52, 55, 63, 66, 67, 76, 80, 84 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Patel et al. (WO 91/06036). Applicants respectfully note that the claim 67 was canceled previously and was not pending in the present application. Moreover, Applicants believe the Examiner intended claim 76, not claim 72, in paragraph 10 on page 3 of the Office Action, as the Examiner's argument in paragraph 16 on page 4 of the Office Action refers to claim 76, not claim 72. Clarification is respectfully requested.

Claim 49 recites that "the coefficient of variation in size within said one or more populations is less than 5%." Patel fails to disclose this feature. The remainder of the claims depend directly or indirectly from claim 49.

Depending on how the light scattering properties of particles are detected, the approximate size and distribution of particle sizes in the particle population can be extremely important [0297]. Applicants have developed a particle growing procedure involving a preparation of “seed” gold particles, which provides narrower distributions in sizes of particles comprising a surface coat [0279],[0280] and [0298]. On the other hand, Patel’s particles are assumed to have a standard deviation of 2 to 8 nm in their coat thickness alone (lines 25-28, page 27). With the constant 20 nm core particle diameter and 1.5 to 8 nm coat thickness, the coefficient of variation in size of Patel’s particles with a surface will result in 7 to 37% ($= (2/(20+28))$ to $(8/20+1.5)$). Moreover, the final coefficient of variation in size of Patel’s particles must be even higher than 7 to 37% once the variation in the core particle diameter is considered in the calculation. Therefore, the coefficient of variation in size of Patel’s particles does not fall within the claimed coefficient of variation in size, less than 5%.

Because Patel does not disclose the coefficient of variation in size feature “less than 5%” of the claimed particle, Applicants respectfully request that this rejection under 35 U.S.C. § 102(b) be reconsidered and withdrawn.

Claim Rejections - 35 U.S.C. § 103(a)

Claims 49-52, 55, 63, 66, 68, 71-73, 76, 80, 84, 166-179 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Margel (US 4,624,923) in view of Rembaum et al. (US 4,929,400) and further in view of Patel et al. (WO 91/06036).

Claim 49 recites that “the coefficient of variation in size within said one or more populations is less than 5%” for particles comprising “a surface coat of gold, silver, or silver

alloy.” Margel, Rembaum and Patel fails to disclose this feature. The remainder of the claims depend directly or indirectly from claim 49.

Margel does not teach or suggest the coefficient of variation in size of the particle with a surface coat as Margel is silent regarding the distribution in the size of polyacrolein microspheres with a surface coat.

Rembaum does not teach or suggest the coefficient of variation in size of the particle with a surface coat as Rembaum’s particle does not even have a surface coating.

Patel does not teach or suggest the coefficient of variation in size of the particle with a surface coat to be less than 5% by the same argument presented previously. The coefficient of variation in size of Patel’s particles teaches away from the claimed coefficient of variation in size, less than 5%.

To establish *prima facie* obviousness of a claimed invention, all the cited references must recite all the claim limitations. *In re Royka*, 490 F.2d 981, 984 (CCPA 1974). For the reasons previously presented above, Applicants contend that neither Margel, Rembaum, Patel, nor the other cited references, alone or in combination, teach or suggest all the claim limitations of the invention, either explicitly or inherently. In particular, these references do not expressly or inherently teach the coefficient of variation in size of the particle with a surface coat to be less than 5%. Thus, these references do not support a *prima facie* case of obviousness. Further, because the cited references do not teach all of the claim limitations, there can be no reasonable expectation of success in combining the cited references to arrive at the claimed invention.

In addition, the Office Action fails to establish a reason as to why one of skill would alter or combine the references in the suggested manner. As the Supreme Court recently discussed,

the “apparent reason to combine the known elements in a fashion claimed by the [claims] at issue ... should be made explicit.” *KSR Int’l Co. v. Teleflex, Inc.* No 04-1350 slip op. at 14 (U.S. Apr. 30, 2007). Rather than indicating why one of skill in the art would choose to combine the references suggested, the Office Action is silent. Further, the Office Action is silent as to why one would pursue the coefficient of variation in size of the particle with a surface coat to be less than 5%. Indeed, there is no reason that one of skill in the art would have in combining the cited references.

For the reasons set forth above, Applicants maintain that the combination of the cited references, taken alone or in combination, fail to recite and teach all the limitations of the claimed invention. Accordingly, Applicants assert that the combination of cited references fails to render obvious the claimed invention.

Applicants therefore respectfully request that this rejection under 35 U.S.C. § 103(a) be reconsidered and withdrawn.

AMENDMENT UNDER 37 C.F.R. §§ 1.111 and 1.121

Attorney Docket No.: A9372

Application No.: 09/932,128

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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